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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 09/870,242 | 05/30/2001 | Jitendra Singh Goela | 51048-2 DIV (3568-33-000) | 9573 |
| 21874 | 7590 | 11/04/2004 | EXAMINER | |
| EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205 | | | EGAN, BRIAN P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1772 | |

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/870,242

Applicant(s)

GOELA ET AL.1

Examiner

Brian P. Egan

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1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 27-30 and 32-34.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10/5/04.
10. ☐ Other: _____

ADVISORY ACTION

1. The applicant's after final response filed October 5, 2004, will be entered for purposes of appeal but fail to place the applicant's claims in condition for allowance.

As detailed by the examiner in the interview summary dated September 24, 2004, the applicant has failed to demonstrate that Suda et al. cannot be scaled to the shell size claimed by the applicants. The examiner does not disagree with the applicant that silicone carbide is a difficult material to scale due to the propagation of cracks. However, Suda et al. directly address the problem associated with the propagation of cracks and have developed a system wherein the thermal expansion of the graphite bore and silicone carbide shell in a chemical vapor deposition process are controlled during the formation process such that the shell does not crack during or after the formation and subsequent removal of the shell from the graphite bore. Absent demonstration of unexpected results, the examiner maintains that it would have been obvious to make larger sized shells using the system defined by Sura et al. Furthermore, even if the larger sized shells of Sura et al. would propagate cracks, the shells would still read on the applicant's claimed invention because even a cracked shell still reads on the applicant's claims. The examiner reiterates the suggestion that the applicant's add the limitation that the shell is "substantially free of cracks" to clarify the fact that the end product does not have any cracks known to form in the prior art discussed by the applicant.

The examiner notes that a statement or argument by the attorney is not factual evidence (see MPEP section 716.01). Therefore, the examiner suggests that the applicant submit evidence in the form of affidavits and/or declarations demonstrating that even if thermal expansion of the bore and shell material are controlled, cracks will still form at larger sized formations of silicone

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carbide shells. Otherwise, the examiner maintains that it would have been obvious to one of ordinary skill in the art to increase the size of the shell detailed by Suda et al.

For the foregoing reasons, the examiner maintains the rejection from the previous office action. The applicant is advised of his right to appeal the examiner's rejection or file a request for continued examination (RCE).

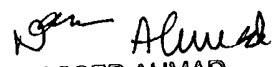
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 571-272-1491. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BPE 11/1/04


NASSER AHMAD
PRIMARY EXAMINER
Acting SPE 11/1/04